Remarks

Applicant thanks the Examiner for the time afforded their undersigned representative on June 29, 2006 regarding this application. The amendments presented herewith are pursuant to the discussions between Examiner Scuderi and Applicant's undersigned representative. Although the amendments submitted herewith are believed to place all claims in condition for allowance, the Examiner is invited to telephone Applicant's undersigned representative should any issued remain unresolved. Claims 1, 2, 6-8, 10, 11, 15-18, 20-22 & 26-28 remain pending.

By this paper, amendments are made to further specify that the requesting by the first wireless device is for a list of active wireless devices from the instant messaging server based on or in a same piconet as the first wireless device. Further, the piconet is more specifically characterized as being implemented with Bluetooth technology and having a range characteristic indicative of a distance within which the radio signals carry between wireless devices of the piconet using direct connection wireless technology. Support for these amendments can be found throughout the application as filed. For example, reference paragraph [0023] of the specification. No new matter is added to the application by any amendment presented.

The amendments submitted herewith are believed to render the rejections stated in the prior-issued final Office Action moot. However, for completeness, the comments previously provided in the paper filed June 5, 2006 regarding certain further aspects of Applicant's claims are repeated below for the Examiner's convenience.

In the final Office Action, claims 1, 2, 7, 8, 10, 11, 16-18, 20-22, 27 & 28 were rejected under 35 U.S.C. §102(e) as being anticipated by Collins et al. (U.S. Publication No. 2003/0112823; hereinafter Collins), while claims 6, 15 & 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Collins. These rejections are respectfully, but most strenuously, traversed and reconsideration and withdrawal thereof are requested.

Applicant requests reconsideration and withdrawal of the anticipation and obviousness rejections on at least the following grounds:

(1) The final Office Action fails to state a *prima facie* case of anticipation against Applicant's claimed invention;

(2) The final Office Action has misinterpreted the teachings of Collins, thus voiding the basis for the rejections; and

(3) The Collins application itself lacks any teaching, suggestion or incentive for further modification as necessary to achieve Applicant's recited invention.

Failure to State a Prima Facie Case of Anticipation:

Applicant recites in independent claims 1, 7, 10, 16, 17, 20, 21 & 27 a particular protocol for establishing direct wireless connection between a first wireless device and a second wireless device. The protocol initially includes connecting the first wireless device to an instant messaging server and obtaining a list of active wireless devices from the instant messaging server for use by the first wireless device in identifying at least one additional wireless device belonging to a same piconet as the first wireless device. Responsive to this process, each of the independent claims then recites variations on the function of:

> *establishing by the first wireless device direct instant messaging communication between the first wireless device and a second wireless device without further employing the instant messaging server.*

Applicant respectfully submits that the final Office Action does not address this aspect of his recited invention. As such, the final Office Action fails to state a *prima facie* case of anticipation against Applicant's claims at issue.

More particularly, the final Office Action repeats the above-noted language from Applicant's independent claims and then states in parentheses:

> 0039, establishing direct connection 406, "note the importance of the directness of communications flow 406: it does not pass through the rendezvous service."

Clearly, Applicant's above-outlined protocol is more than simply establishing direct connection between two wireless devices. For example, Applicant recites that *responsive to the employing, establishing by the first wireless device direct instant messaging communication between the first wireless device and a second wireless device without further employing the instant messaging server*. These aspects of Applicant's protocol that the establishing of the direct communication is by the first wireless device, and is without further employing of the instant messaging server,

are not addressed in the final Office Action's comments other than a general reference to paragraph [0039] of Collins.

Paragraph [0039] of Collins states:

> In the first example, illustrated by FIGS. 4a and 5a, computing devices 100 and 112 establish communications flows, 402 and 404, respectively, with the rendezvous service 400. While the corresponding steps 500 and 502, of FIG. 5a are shown as occurring simultaneously, that need not be the case. Possibly using a discovery or naming service provided by the rendezvous service, device 112 decides to communicate with device 100. In step 504, device 112 invites device 100 to establish communications. The invitation is sent to the rendezvous service rather than directly to device 100. In step 506, the rendezvous service attempts (after possible translations not relevant to the present discussion) to pass the invitation along to device 100. Even though device 100 is behind the communications blocker 104/200, the already established communications flow 402 allows the invitation to reach device 100. Upon receiving the invitation, device 100 in step 508 attempts to establish communications with device 112. Because there is no communications blocker in front of device 112, the attempt succeeds and devices 100 and 112 establish communications flow 406 with one another. In the parallel steps 510 and 512, devices 100 and 112 use communications flow 406 to communicate directly with one [an]other. Note the importance of the directness of communications flow 406: it does note pass through the rendezvous service. That service is used only for signaling during establishment of the direct, peer-to-peer connection.

A careful reading of the cited paragraph from Collins fails to uncover any teaching or suggestion of the particular protocol at issue in Applicant's independent claims. Since the final Office Action is devoid of any discussion of this feature of Applicant's invention, and since the cited paragraph in Collins is devoid of any reference of such a feature, it is respectfully submitted that the final Office Action fails to state a *prima facie* case of anticipation against the claims at issue. There is no establishing *by a first wireless device* direct instant messaging communication between the first wireless device and a second wireless device *without further employing the instant messaging server* taught or suggested by Collins. As such, reconsideration and withdrawal of the rejections stated in the final Office Action are respectfully requested.

The Final Office Action Mischaracterizes the Teachings of Collins:

In addition to the failing to state a *prima facie* case of anticipation against the independent claims at issue, Applicant respectfully submits that the final Office Action mischaracterizes the teachings of Collins in applying the Collins application to his recited

invention. In particular, Applicant respectfully submits that the final Office Action mischaracterizes Collins to the extent that it alleges that his above-highlighted protocol of establishing by the first device direct instant messaging communication between the first device and the second device *without further employing the instant messaging server* is taught, or even suggested, by Collins.

Clearly, there is often more than one way to achieve a desired result. In the instant case, the desired result is a direct instant messaging communication or direct wireless communication between the first wireless device and the second wireless device. Similarly, to the extent relevant to this point, Collins describes the goal of establishing a direct communications flow 406 between devices 100 and 112 (see [0039] of Collins). However, the protocol or process for achieving this result is significantly different between Applicant's invention and the Collins application.

In Applicant's invention, the communications medium is recited to comprise a same piconet within which the first and second wireless devices communicate. As defined in paragraph [0023] of Applicant's specification, a piconet is a network of devices connected in an *ad hoc* fashion *using direct connection wireless technology*, such as Bluetooth technology. Inherent in Applicant's recited invention is that connection information accompanies the list of active wireless devices from the instant messaging server to the first wireless device. This is because the independent claims recite that the first wireless device, after identifying the second wireless device, directly establishes instant messaging communication *without further employing the instant messaging server*. This is clearly a process or protocol distinct from that described by Collins.

In Collins, it is stated in paragraph [0039] that:

- Device 112 invites device 100 to establish communications.
- The invitation is sent to the rendezvous service rather than directly to device 100.

Clearly, since the invitation by first wireless device 112 is sent to the rendezvous service (which is analogized in the final Office Action with Applicant's recited instant messaging server), Collins teaches a process different from that recited by Applicants. In Applicant's invention, the direct instant messaging communication is established by the first wireless device *without further employing the instant messaging server.*

Further, Collins teaches in paragraph [0039]:

- In step 506, the rendezvous service attempts (after possible translations not relevant to the present discussion) to pass the invitation along to device 100. Even though device 100 is behind the communications blocker 104/200, the already established communications flow 402 allows the invitation to reach device 100.

- Upon receiving the invitation, device 100 in step 502 attempts to establish communications with device 112.

Because of the presence of the communications blocker 104/200, it is respectfully submitted that Collins must attempt establishing of direct communication between the devices employing the rendezvous service. It is the rendezvous service which has already established communications flow 402 that allows the invitation to reach device 100. Without communications flow 402, device 112 would not be able to pass through communications blocker 104/200 to device 100. Thus, Collins clearly teaches a different protocol or process for establishing direct communications between a first and second device. In Collins, the rendezvous server is necessarily involved and relied upon by the first device in initiating the second device's attempt to establish communication flow 406 to the first device.

Since it is well settled that there is no anticipation of a claim unless a single prior art reference discloses: (1) all the same elements of the claimed invention; (2) found in the same situation as the claimed invention; (3) united in the same way as the claimed invention; and (4) in order to perform the identical function as the claimed invention, the above-outlined distinction necessitates the conclusion that there is no anticipation of Applicant's independent claims based upon the teachings of Collins. For this additional reason, reconsideration and withdrawal of the rejection stated in the final Office Action are respectfully requested.

Collins Lacks any Teaching, Suggestion or Incentive for its Further Modification as Necessary to Achieve Applicant's Recited Invention:

As indicated by the title and abstract, Collins is directed to processes for enabling communication to be established *regardless of the presence of communication blockers*, such as firewalls and Network Address Translators (NATs), in the path between the two computing devices. Thus, Collins describes (throughout the application) processes for indirectly establishing direct communication employing a rendezvous service. Removal of the rendezvous service from establishing of the direct instant messaging communication between the first and second wireless devices is not possible because of the existence of communications blocker 104/200. Further, removal of communications blocker 104/200 from the Collins patent would render the patent meaningless, since the teachings described therein are processes for establishing communications through firewalls and Network Address Translators (NATs).

For this additional reason, Applicant respectfully requests reconsideration and withdrawal of the rejection stated in the final Office Action.

Applicant respectfully submits that the independent claims patentably distinguish over the teachings of Collins. The dependent claims are believed allowable for the same reasons as the independent claims, as well as for their own additional characterizations.

Thus, all claims are believed to be in condition for allowance, and such action is respectfully requested.

Respectfully submitted,

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